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03/20/2002

George Endel Deckner

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ART UNIT

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1616

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/009,083  
Filing Date: March 20, 2002  
Appellant(s): DECKNER ET AL.

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Roddy M. Bullock  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on October 06, 2005 appealing from the Office action mailed on February 23, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

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The copy of the appealed claims contained in the Appendix to the brief is correct. Claims 1-36 are pending and are rejected.

**(8) Evidence Relied Upon**

US 6570054	GATTO et al	05-2003
WO 98/55158	OSBORN et al	12-1998
WO 99/22684	ROE et al	05-1999
WO 99/12530	VAN RIJSWIJCK et al	03-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by GATTO et al (US 6570054 B1). GATTO et al discloses an absorbent article having a stable skin care composition disposed on its skin-contacting surface. See the entire document, especially the abstract, Tables 1-5, claims, lines 5-43 in col. 9, as well as the specific citations cited below.

GATTO et al discloses, "The composition can also be applied to a given component (e.g., topsheet, cuffs, sides, waist, etc.), at the converting site or by the material supplier, before it is combined with the other raw materials to form a finished disposable absorbent product. **Again, the composition can be applied to other zones of the article such that the composition will migrate to one or more wearer contacting surfaces during use.** The composition is typically applied from a melt thereof to the article. In a preferred embodiment, the composition fully melts at a temperature significantly above room temperature, it is usually applied as a heated composition to the article. **Typically, the composition is heated to a temperature in the range from about 35°C to about 150°C, preferably from 40°C to about 100°C, prior to being applied to the article.** The skin care ingredient may be added to the composition prior to or after

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heating. Special care should be taken when heat-sensitive ingredients are used, for example, protease inhibitors or enzyme inhibitors.”<sup>1</sup>

The immobilizing agent used in the instant invention, behenyl alcohol in the examples of the Specification, is disclosed in the examples of the reference.<sup>2</sup>

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

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<sup>1</sup> See line 35 to line 55 in column 35.

<sup>2</sup> See Table 3 to Table 5.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of OSBORN et al (WO 98/55158), VAN RIJSWIJCK et al (WO 99/12530), and ROE et al (WO 99/22684). The presently claimed invention is generically taught by the prior art.

OSBORN et al teaches an absorbent device that is pretreated with an emollient composition. The preferred melting points of the immobilizing agents are "of at least about 40 degrees Celsius".<sup>3</sup> See the entire document, especially the abstract, examples, claims, the third paragraph on page 21, the last paragraph on page 22, and all of page 23.

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<sup>3</sup> See second to last paragraph on page 28.

VAN RIJSWIJCK et al teaches a skin care composition that provides a therapeutic and/or protective skin benefit upon transfer to the skin by a device. The preferred melting points of the immobilizing agents are "of at least about 40 degrees Celsius."<sup>4</sup> See the entire document, especially the abstract, claims, examples, the first paragraph on page 13, all of page 14, and the first & second paragraphs on page 19, and claim 10.

ROE et al teaches a skin care composition to maintain and/or improve skin health of the wearer upon transfer during use. It also teaches semisolid compositions. See the entire document, especially the abstract, examples, claims, and the first paragraph of page 41.

Instant claims differ from the prior art in claiming a broader scope.

It would have been obvious to one skilled in the art at the time of invention to prepare an absorbent article comprising a body contacting surface and an absorbent core by containing a skin care composition because the prior art teaches it. There is motivation to prepare the presently claimed invention by selecting the ingredients taught by the prior art *supra* for the same use. The prior art teaches absorbent article, the composition, the immobilizing agent, the melting point of the temperature (solid or semisolid at 40 degrees Celsius), and all other ingredients.

The Examiner notes the proportions, ranges, ratios, concentrations, and temperatures are claimed in various independent claims. It has been established that normally, change in temperature, concentration, or both, is not a patentable modification; however, such changes may impart patentability to a process if the ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from results of prior art; such ranges are

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<sup>4</sup> See the first paragraph on page 46.



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termed "critical" ranges, and applicant has burden of proving such criticality; even though applicant's modification results in great improvement and utility over prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art; more particularly, where the general conditions of the claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation. *In re Aller et al.* 105 USPQ 233.

It is well established that merely selecting proportions and ranges is not patentable absent a showing of criticality. *In re Becket*, 33 U.S.P.Q. 33 (C.C.P.A. 1937). *In re Russell*, 439 F.2d 1228, 169 U.S.P.Q. 426 (C.C.P.A. 1971).

It is a general rule that merely discovering and claiming a new benefit of an *old* process cannot render the process again patentable. Nor can patentability be found in differences in ranges recited in the claims. When the difference between the claimed invention and the prior art is some range or other variable within the claims, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range. *In re Woodruff*, 16 USPQ2d 1934.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In absence of any criticality and/or unexpected results, presently claimed invention is considered *prima facie* obvious over the prior art of record.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

#### **(10) Response to Argument**

##### Rejection Under 35 USC § 102(e)

Applicants argue that GATTO et al (US Patent No. 6570054) does not teach each and every element in claims 1 and 30. "For, [*sic*] example, Gatto discloses an article having a skin care composition that is solid or semisolid at 40°C because its' melt temperature is 35°C. Therefore, Gatto cannot anticipate the Applicants' claims 1 and 30."<sup>5</sup>

The Examiner respectfully disagrees.

GATTO et al discloses, "The composition can also be applied to a given component (e.g., topsheet, cuffs, sides, waist, etc.), at the converting site or by the material supplier, before it is combined with the other raw materials to form a finished disposable absorbent product. **Again, the composition can be applied to other zones of the article such that the composition will migrate to one or more wearer contacting surfaces during use.** The composition is typically applied from a melt thereof to the article. In a preferred embodiment, the composition fully melts at a temperature significantly above room temperature; it is usually applied as a heated

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composition to the article. **Typically, the composition is heated to a temperature in the range from about 35°C to about 150°C, preferably from 40°C to about 100°C, prior to being applied to the article.** The skin care ingredient may be added to the composition prior to or after heating. Special care should be taken when heat-sensitive ingredients are used, for example, protease inhibitors or enzyme inhibitors.”<sup>6</sup>

As is clear from the cited text above, the reference directly discloses the instant invention. The immobilizing agent used in the instant invention, behenyl alcohol in the examples of the Specification, is disclosed in the examples of the reference.<sup>7</sup> **Of further note, the instant invention's range is within the range of the reference.**

Even if the reference does not teach the range, it has been established that normally, change in temperature, concentration, range, etc. is not a patentable modification; however, such changes may impart patentability to a process if the ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from results of prior art; such ranges are termed "critical" ranges, and applicant has burden of proving such criticality; even though applicant's modification results in great improvement and utility over prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art; more particularly, where the general conditions of the claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation. In re Aller et al. 105 USPQ 233.

The Examiner would like to note that it does not matter what the intended use of the composition is; it has been ruled by the courts that even in a case where the reference does not

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<sup>6</sup> See line 35 to line 55 in column 35.

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teach the same use of the composition, the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau*, 57 USPQ 324; *Ex parte Douros*, 163 USPQ 667; and *In re Craige*, 89 USPQ 393.

The Applicants argue that because GATTO et al only teaches the lotion composition in a melt state at 40°C and not specifically as a solid or semisolid, the instant invention should be allowed. The Applicants call it “sufficient precision”---that although the reference implies it, it is not precise enough for a rejection.

The Examiner respectfully disagrees. The Applicants are essentially arguing that if a reference discloses composition F in a liquid state and adds in the specification that the composition can also be used in other forms, that they should be able to patent that composition in other forms because the original inventors did not disclose with “sufficient precision”.

As for the Applicants’ argument regarding GATTO et al failing to anticipate each and every single dependent claim: the Examiner does not find this argument to be persuasive. The dependent claims are not different from independent claims 1 and 30. The Applicants have not shown what’s so different about these dependent claims that requires the Examiner to address each claim individually.

The Examiner does not find any criticality.

#### Rejection Under 35 USC § 103(a)

The Applicants argue that there is no motivation for one skilled in the art to combine the teachings of OSBORN et al, VAN RIJSWIJCK et al, and ROE et al. The Examiner respectfully

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<sup>7</sup> See Table 3 to Table 5.

disagrees. There is motivation to combine the teachings of these references because they are in the same field and all teach similar compositions.

The Applicants argue that the Specification discusses criticality of the temperature at which the skin care composition is semisolid and solid on page 22, lines 27-34 to page 23, "lines" 23 and the criticality of the viscosity ranges on page 23, lines 25-35 to page 24, lines 1-2.<sup>8</sup>

*None* of the referred citations of the Specification discuss the criticality of the temperature at which the skin care composition is semisolid and solid or the criticality of the viscosity ranges.

As a matter of fact, the prior art teaches the range of the temperature, the specific immobilizing agents (Specifically behenyl alcohol) and all the components as presently claimed.

The Applicants argued in the previous Response, "...the specification makes it clear that the Applicants chose different parameters for the skin care composition to get results that meet needs previously unsatisfied by the prior art."<sup>9</sup> The Applicants have not answered these questions the Examiner asked in the previous Office Action: What are those parameters? Where is the criticality? What are the results that meet needs previously unsatisfied by the prior art?

One skilled in the art would have been motivated to prepare the presently claimed invention because of the combination of OSBORN et al, VAN RIJSWIJCK et al, and ROE et al. Applicants are reminded that the rejections are being made on the combined teachings of the references. Furthermore, there is motivation to combine the teachings of these references because they are in the same field and all teach similar compositions.

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It has been ruled by the courts that a reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

**Accordingly, the burden of proof is upon applicants** to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In absence of any criticality, the instant invention is considered *prima facie* obvious.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the examiner in the Related Appeals and Interferences section of this examiner's answer identifies the Board.

For the above reasons, it is believed that the rejections should be sustained.

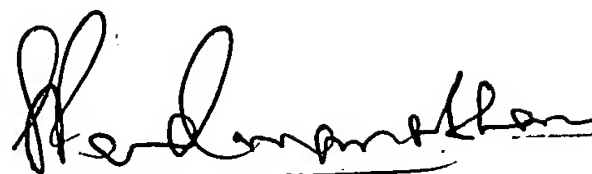
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**Thursday**  
**April 27, 2006**